

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed June 26, 2008 and the Advisory Action mailed September 11, 2008. Currently, claims 1-21 remain pending. Claims 1-21 have been rejected. Claim 1 has been amended to clarify the relationships among the elements. No new matter was added. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections – 35 USC § 102

Claims 1-5 and 13-21 were rejected under 35 U.S.C. 102(e) as anticipated by Walak et al. (U.S. Patent 6,540,757), hereinafter Walak. After careful review, Applicant must respectfully traverse this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

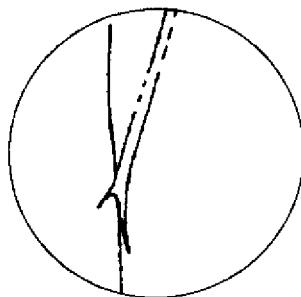
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (See MPEP § 2131).

Applicant notes that the Examiner’s rejections of independent claim 1 have focused upon the issue of whether the anchors (50) of Walak et al. (U.S. Patent No. 6,540,767, hereinafter Walak) characterized by Walak as “sharp projections or barbs”, may be said to provide the “cutting member” of claim 1. The distinction between the outward wall engaging anchor and the inward facing edged blade cutting member has been clarified in amended claim 1, reproduced in its entirety below:

1. An intravascular filter having a central axis comprising:
an elongate member;
an anchoring member for anchoring the intravascular filter to a vessel wall attached to the elongate member; and
an elongate edged blade cutting member disposed along the elongate member proximate the anchoring member, wherein the edge of the edged blade generally faces towards the central axis.

It has been the Examiner’s position that the anchors (50) of Walak are capable of providing a “cut” within a definition supplied by the Examiner: “to penetrate with or as

if with an edged instrument” while the Appellants have maintained that the barbs of the anchors would not provide a “cutting edge” or an “edged instrument” as that term would be understood by one of ordinary skill in the art to which the invention applies. Further, Applicant has consulted additional reference dictionaries and has found agreement with the Merriam-Webster definition provided by the Examiner in that each of the common definitions of “cut” include one or more of the phrases: “edged instrument”, “sharp-edged instrument”, “sharp-edged implement”, and “sharp edge”. None of those definitions, including that provided by the Examiner, included the word “barb” or “projection”. Anchors (50) are characterized by Walak as “sharp projections” which would be understood to tend to partially pierce the vessel wall in their function as an anchor. Walak characterizes anchors (50) as: “In FIG. 1, anchors 50 and 52 are pictured as sharp projections or barbs.” and later as: “In the embodiment shown in FIG. 1 anchors 50 and 52 include a plurality of sharp projections which penetrate the walls of blood vessel 22.” (Column 4, lines 16-17 and 47-48.) Thus the anchors disclosed by Walak appear to be limited to sharp projections which penetrate the walls of the blood vessel. The piercing action of the anchor appears to be limited by the adjacent free end of the strut, as illustrated in the detail of Figure 1 below, to prevent undesirable cutting or tearing of the vessel wall (vertical line to the left) with attendant bleeding into the surrounding tissue.



The Examiner has asserted in section 7 of the Final Office Action that the free ends (40) of struts (32) as “clearly show that the filter device of Walak has barbs that are facing inwardly” (i.e., lying to the right of the vertical line representing the vessel wall which is penetrated by the anchor (50) which extends to the left and into the wall) indicating the downward extension of strut (32) below the anchor’s barb by means of an arrow and labeling that extension “cutting member facing inwardly”. The Examiner

further asserts that “The barbs of Walak is viewed as an edge instrument used to penetrate tissues.” (sic) Examination of the detail above will show that the portion of strut (32) indicated by the Examiner’s arrow, that which extends below anchor barb (50), does not appear to penetrate tissue, as would be required to be an anchor of Walak, or generally face towards the central axis, but rather lies generally parallel to the vessel wall thereby limiting the penetration of the barb to minimize tearing.

In focusing on the distinction between “cutting” and the partial penetration of the vessel wall by the barb of an anchor, both parties have neglected other features of the claims. In particular, pending claim 1 requires an elongate member having both “an anchoring member for anchoring the intravascular filter to a vessel wall” and “an elongate edged blade cutting member disposed along the elongate member proximate the anchoring member, wherein the edge of the edged blade generally faces towards the central axis”. Of these, Walak appears to mention only anchors, which necessarily face away from the central axis of the filter in order to engage the wall of the vessel. Walak does not mention a blade cutting member, whether barbed or edged, which is disposed along the elongate member, the edge of which generally faces the central axis. Accordingly, the disclosure of Walak appears limited to sharp penetrating barbs which form outward facing anchors and does not provide a separate cutting member in addition to the anchors, specifically a cutting member which faces toward the central axis. The free end of strut (32) does not generally face toward the central axis.

As will be seen in Figure 7, reproduced below, the cutting member blade (112) of the pending claims must face generally toward the central axis in order to provide its function, severing intima (124) which tends to encapsulate the tip of the elongate member (102) after the filter has been in place for sufficient time for neointimal hyperplasia to occur. Encapsulation makes it difficult to disengage anchor member (104) from the media (122) and the adventitia (120) of the vessel wall without tearing the intima thereby increasing trauma to the vessel wall. The cutting edge of the Examiner’s definition of “cut” may be found in element (110) which faces generally inward as opposed to the barb of an anchoring element which faces generally outward as it must to engage the vessel wall.

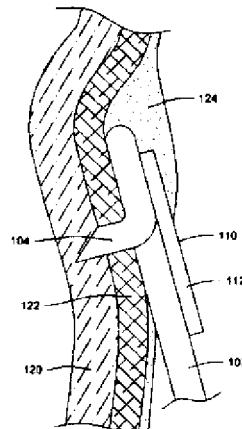


Figure 7

As will be seen from the above discussion, Walak provides neither the inward facing blade cutting member nor any alternate inward facing structure which provides a similar function. For at least the reasons mentioned above, Walak does not disclose each and every element as set forth in the claims, either expressly or inherently described. Thus Claims 1-5 and 13-21 are believed to be not anticipated by Walak and Applicant respectfully requests that the rejections be withdrawn.

Additionally, for similar reasons, as well as others, claims 2-21, which depend from claim 1 and include significant additional limitations, are believed to be patentable and nonobvious in view of Walak and Applicant respectfully requests that the rejections be withdrawn.

Claim Rejections – 35 USC § 103

Claims 6-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Walak. After careful review, Applicant must respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03).

In rejecting Claims 6-12 under 35 U.S.C § 103, the Examiner relies upon Walak as applied to Claim 1 and further asserts that the additional limitations of the dependent claims in question are variations of the blade cutting member of independent Claim 1, shown above to be absent from the disclosure of Walak, that would have been obvious to one of ordinary skill in the art. Appellant asserts that it would not have been obvious to

one of ordinary skill in the art both to provide and to modify an element entirely missing from Walak. Accordingly independent Claim 1 is nonobvious under 35 U.S.C § 103.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03) For at least this reason, Applicants respectfully request that the rejections of nonobvious dependent claims 6-12 be withdrawn.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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